REMARKS

Claims 1-28 and 30-32 are all the claims presently pending in the application. Claims 1, 4, 6, and 9-10 are amended to more clearly define the invention. Claims 1, 6, 9-10, 13, and 24 are independent.

These amendments are made only to more particularly point out the invention for the Examiner and not for narrowing the scope of the claims or for any reason related to a statutory requirement for patentability.

Applicant also notes that, notwithstanding any claim amendments herein or later during prosecution, Applicant's intent is to encompass equivalents of all claim elements.

Claims 13-18 and 21-23 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Henderson (U.S. Patent No. 6,611,681 B2). Claims 1-12 and 31-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brennan (U.S. Patent No. 5,903,628) in view of Muramatsu (U.S. Publication No. 2001/0051536 A1) and in further view of Henderson. Claims 19-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Henderson and further in view of Muramatsu. Claims 24-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brennan in view of Henderson. Claims 27-28 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brennan in view of Henderson and further in view Muramatsu.

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

A first exemplary embodiment of the claimed invention, as defined, for example, by independent claim 1, is directed to a mobile communications terminal device that includes

storage means for registering beforehand a name of an originator, one of a telephone number and a mail address of the originator, a kind of an incoming identification tone at a time of a call incoming from the originator, and a character string input by a user corresponding to a voice information designating the originator, voice output means for ringing with the kind of the incoming identification tone corresponding to the originator at the time of the call incoming, and control means for controlling the voice output means to output the voice information corresponding to the character string registered beforehand in the storage means in response to an instruction received from the user while the voice output means is ringing.

A second exemplary embodiment of the claimed invention, as defined, for example, by independent claim 13, is directed to a mobile communications terminal that includes a memory storing a character string input by a user for the calling party, the character string to be retrieved from the memory upon a receipt of a call from the calling party for outputting voice information and upon receipt of an instruction from a user during an incoming call.

Conventional mobile terminals have displayed a caller's data from a telephone directory when a call is received from that caller. However, a user of the mobile terminal cannot easily identify the caller if the display is not visible.

Other conventional mobile terminals output a tone that identifies a caller when a call is received from that caller. However, it is difficult for a user to accurately and easily identify a caller if a large number of caller and identifying tones are stored.

In stark contrast, the mobile terminal in accordance with an exemplary embodiment of the present invention outputs voice information based upon a character string that was stored before the call from the party by the user of the mobile terminal. In this manner, when an originator's information cannot be easily identified based upon the display the user can obtain

voice information that was input by the user, and which, therefore, the user is more likely to recognize the caller. (Page 11, lines 4-20).

Additionally, since it is not necessarily beneficial to the user for the mobile terminal to be automatically output since the originator's information may be undesireably heard in the surroundings, the present invention outputs the voice information in response to receipt of an instruction from a user during an incoming call. (Page 9, lines 1-17).

II. THE 35 U.S.C. § 112, FIRST PARAGRAPH REJECTION

The Examiner alleges that claims 9-10 and 13 are not enabled by the specification. In particular, the Examiner alleges that claims 9-10 and 13 are "single means" claims. However, contrary to the Examiner's allegation, none of claims 9-10 and 13 recite either a "step for" or a "means for" performing a function and, therefore, none of the claims 9-10 and 13 recite any means-plus-function limitation which might be subject to a prohibition against "single means."

The Court in *In re Hyatt*, 708 F.2d 712, made it clear that a "single means claim" is "a claim drafted in 'means-plus-function' format yet reciting only a single element instead of a combination." *Id* at 713. The claim at issue in In re Hyatt was "not disputed that it is drafted in means-plus-function format." *Id* at 714. More specifically, the *In re Hyatt* court held:

> "The final paragraph of Sec. 112 saves combination claims drafted using means-plus-function format from this [enablement] problem by providing a construction of that format narrow enough to avoid the problem of undue breadth as forbidden by the first paragraph. But no provision saves a claim drafted in means-plus-function format which is not drawn to a

combination, i.e., a single means claim." Emphasis added, *Id* at 715.

In other words, the Court in *In re Hyatt* only prohibited claims that were drafted in a means-plus-function format and which recited only a single means from being capable of satisfying the first paragraph of 35 U.S.C. § 112.

With respect to claims 9-10 and 13, none of these claims are drafted in a means-plus-function format and, therefore, the prohibition against single means claims is inapplicable.

> The M.P.E.P. makes it very clear that "a claim element that does not include the phrase 'means for' or 'step for' will not be considered to invoke 35 U.S.C. § 112, sixth paragraph. . . . Thus, absent an express recitation of 'means for' or 'step for' in the limitation, the broadest reasonable interpretation will not be limited to 'corresponding structure . . . and equivalents thereof."
>
> M.P.E.P. § 2181.I.

Therefore, United States Patent law is very clear that a feature that recites a "means for" or "step for" will not be considered to be in a means-plus-function format subject to the prohibition against a single means limitation. Indeed, the M.P.E.P. specifically prohibits the Examiner from taking an alternative position.

Thus, since none of claims 9-10 and 13 recited either "means for" or a "step for" language, none of these claims are in a means-plus-function format, and, as a result, are not subject to the restrictions against single means claims

In view of the foregoing, the Examiner is respectfully requested to withdraw this rejection.

III. THE PRIOR ART REJECTIONS

A. The 102(e) Henderson reference rejection

Regarding the rejection of claims 13-18 and 21-23, the Examiner continues to allege that the Henderson reference teaches the claimed invention.

Applicant respectfully submits that the Examiner has failed to comply with the clear requirements that are set forth in the Manual of Patent Examining Procedure. In particular, the Examiner has failed to comply with the requirements of the M.P.E.P. as set forth in § 707.07(f) by failing to answer all material traversed.

> *"Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." (M.P.E.P. § 707.07(f), emphasis added).*

Specifically, in the Amendment that was filed on April 29, 2005, the Applicant pointed out that the distinction between caller identification data is received from the telephone line as disclosed by the Henderson et al. reference and the character string that is input by a user as recited by independent claim 13.

Clearly the Examiner has failed to address this traversal. Indeed, the Examiner does not mention anything at all regarding the distinction between caller identification data is received from the telephone line as disclosed by the Henderson et al. reference and the character string that is input by a user as recited by independent claim 13.

While the currently pending Office Action includes a section entitled "Response to Arguments," that section fails to answer the substance of the Applicants' traversal. The Examiner's "Response to Arguments" fails to address the distinction between caller identification data is received from the telephone line as disclosed by the Henderson et al.

reference and the character string that is input by a user as recited by independent claim 13.

In view of the Examiner's failure to address Applicant's traversal, Applicant respectfully submits that the Examiner is not furthering prosecution by ignoring issues regarding the very clear deficiencies in the Examiner's rejection that have been pointed out by the Applicant.

Applicant again respectfully points out that the Henderson reference does not teach or suggest the features of independent claim 13, including a memory storing a character string that was input by a user for the calling party. As explained above, this feature in combination with the other features of independent claim 13 are important for obtaining voice information by providing the instruction to the phone when an originator's information cannot be easily identified based upon the display and outputting the voice information that is easily recognizable by the user.

Rather, and in stark contrast, the Henderson reference discloses a method and apparatus for an improved call interrupt feature in a cordless telephone answering device where the device may provide a speech synthesized version of caller identification data to a cordless telephone after the called party presses the "talk" button. (Col. 6, lines 1-6, and col. 6, line 64 - col. 7, line 10).

In particular, the Henderson reference discloses that the caller identification data is received from the telephone line (Figure 1, col. 6, lines 1-6) and is completely different and unrelated to the character string that is input by a user as recited by independent claim 13.

Indeed, the Henderson reference only discloses that the caller identification data may be output by a speech synthesizer and does not teach or suggest outputting any data at all that may have been input by a user, let alone a character string input by a user.

The Henderson reference clearly does not teach or suggest a character string input by a user, let alone outputting voice information that is derived from the character string that is input by the user.

Therefore, the Henderson reference does not teach or suggest each and every element of the claimed invention and the Examiner is respectfully requested to withdraw this rejection of claims 13-18 and 21-23.

B. The Brennan reference in view of the Muramatsu reference and in further view of the Henderson reference

Regarding the rejection of claims 1-12, and 31-32, the Examiner alleges that the Muramatsu reference would have been combined with the Brennan reference and further alleges that the Henderson reference would have been combined with the Muramatsu reference and the Brennan reference to form the claimed invention. Applicant submits, however, that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

Again, Applicant notes that the Examiner has very clearly failed to address the Applicants traversals regarding the complete and utter lack of any motivation to combine the references as alleged by the Examiner.

Rather, the Examiner merely regurgitates the very same allegations regarding a motivation to combine the reference despite the multiple deficiencies which prevent the Examiner from relying upon such an alleged motivation.

Therefore, again, Applicant submits that the Examiner has again failed to comply with the clear requirements that are set forth in the Manual of Patent Examining Procedure. In

particular, the Examiner has failed to comply with the requirements of the M.P.E.P. as set forth in § 707.07(f) by failing to answer all material traversed.

Indeed, the Examiner does not mention anything at all about Applicant's traversals.

Applicant again submits that these references would not have been combined as alleged by the Examiner. Indeed, the references are directed to completely different and unrelated matters and problems.

Specifically, the Brennan reference is directed to providing a telephone system that automatically answers a telephone so that "someone in a hands-busy situation or a handicapped individual may have calls from pre-selected callers automatically connected." (Abstract).

In stark contrast, the Muramatsu reference is specifically directed to identifying a caller using sound alone without reducing the number of available communication lines ([0011] - [0013]).

In contrast to the Brennan reference and the Muramatsu reference, the Henderson reference is directed to the completely different and unrelated problem of providing an improved call interrupt feature for a telephone answering device that permits the telephone answering device to reestablish control over the message handling function without depending upon an elapse of time or an off-hook condition (col. 2, lines 15-21).

One of ordinary skill in the art who was concerned with providing a telephone system that automatically answers a telephone so that someone in a hands-busy situation or a handicapped individual may have calls from pre-selected callers automatically connected, as the Brennan reference is concerned with providing, would not have referred to the Muramatsu reference. That is, the Muramatsu reference is concerned with the completely different and

unrelated problem of identifying a caller using sound alone without reducing the number of available communication lines.

Further, one of ordinary skill in the art who was concerned with providing a telephone system that automatically answers a telephone so that someone in a hands-busy situation or a handicapped individual may have calls from pre-selected callers automatically connected, as the Brennan reference is concerned with providing, or who was concerned with identifying a caller using sound alone without reducing the number of available communication lines as the Muramatsu reference is concerned would not have referred to the Henderson reference. That is, the Henderson reference is concerned with the completely different and unrelated problem of providing an improved call interrupt feature for a telephone answering device that permits the telephone answering device to reestablish control over the message handling function without depending upon an elapsed time or an off-hook condition.

Thus, the references would not have been combined.

Further, Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner.

The Examiner alleges that it would have been obvious to modify the automatic answering system that is disclosed by the Brennan reference to "allow the user to recognize whom is calling before the phone goes off-hook."

However, contrary to the Examiner's allegation, one of ordinary skill in the art would not have been motivated to modify the Brennan reference to "allow the user to recognize whom is calling before the phone goes off-hook" because the answering system that is disclosed by the Brennan reference already allows "the user to recognize whom is calling before the phone goes off-hook."

As is clearly illustrated by the flowchart of Figure 2 of the Brennan reference, the announcement which allows " the user to recognize whom is calling" is performed in step 67, where the handsfree speaker announces the name, then in step 69 the answering system determines if the announcement is complete and, only when the announcement is complete, "the phone goes off-hook." (Col. 3, lines 27-47).

Indeed, the Brennan reference specifically states that "a user will first hear the name of a caller announced and the call will then be connected." (Col. 3, lines 47-50).

Therefore, since the Brennan reference already allows "the user to recognize whom is calling before the phone goes off-hook," clearly, there is no motivation to modify the Brennan reference in order to "allow the user to recognize whom is calling before the phone goes off-hook" as alleged by the Examiner.

Additionally, the Examiner admits that the Brennan reference does not teach or suggest outputting the voice information in response to an instruction received from a user.

The Examiner then attempts to remedy the deficiencies of the Brennan reference by referring to the Henderson reference which appears to disclose outputting caller identification data as voice data in response to a user input.

However, contrary to the Examiner's allegation, one of ordinary skill in the art would not have modified the system that is disclosed by the Brennan reference because such a modification would destroy the intended purpose of the system that is disclosed by the Brennan reference.

Indeed, as explained previously, the Brennan reference very clearly teaches away from making any such modification.

In stark contrast, the Brennan reference discloses an automatic answer feature for a

telephone that automatically outputs a name from a speech synthesizer without requiring any instruction at all from a user during the incoming call.

In particular, the Brennan reference explains that "Upon completion of a predetermined number of ring cycles (usually only one) . . . the main controller 34 compares the decoded telephone number (or, if no telephone number, the decoded name) to the telephone numbers (or names) previously entered into the telephone directory 48 (step 64). If there is a match . . . . the name in the matching record is read from the telephone directory 84 . . . [and] the main controller 34 forwards the read name to the speech synthesizer 80 (step 65) which translates the read name into a voice announcement signal which is output to the handsfree speaker." (Col. 3, lines 3 - 31).

Thus, the automatic telephone answering system that is disclosed by the Brennan reference suffers from the same problem that is solved by the present invention.

In other words, the automatic telephone answering system that is disclosed by the Brennan reference automatically outputs the name as a voice announcement to the handsfree speaker. Therefore, the voice announcement is heard in the surroundings of the phone without the user of the telephone doing anything.

In stark contrast, the present invention avoids having the voice information automatically being heard in the surroundings by outputting the voice information in response to an instruction from the user during the incoming call.

Therefore, the Brennan reference actively teaches away from the present invention.

M.P.E.P. § 2145 X. D. 2. states:

"It is improper to combine references where the references teach away from their combination." (Emphasis added).

As explained above, the present invention avoids having the voice information automatically being heard in the surroundings by outputting the voice information in response to an instruction from the user during the incoming call.

In stark contrast, the Brennan reference teaches away from outputting voice information in response to an instruction from the user during the incoming call by providing an automatic telephone answering system which automatically outputs the voice information to the surroundings because the "operation is useful where the user is handicapped, infirm, or working in a hands-busy situation." (Col. 3, lines 48-57).

In other words, the Brennan reference teaches that the user may be "handicapped, infirm, or working in a hands-busy situation" and, therefore, may be unable to provide an instruction when receiving the incoming call in order to output the voice information into the surroundings. Therefore, the Brennan reference teaches that it is not desirable to require any instruction at all from a user before outputting the voice information into the surroundings.

Clearly, one of ordinary skill in the art would not have been motivated to modify the teachings of the Brennan reference to require that a user input be received before outputting voice information when the Brennan reference specifically teaches that it is not desirable to require any instruction at all from a user before outputting the voice information.

One of ordinary skill in the art at the time the invention was made would not have been motivated to combine these references to form the claimed invention.

Therefore, the Examiner is respectfully requested to withdraw the rejection of claims 1-12, and 31-32.

C. The Henderson reference in view of the Muramatsu reference

Regarding the rejection of claims 19-20, the Examiner continues to allege that the Muramatsu reference would have been combined with the Henderson reference to form the claimed invention.

Again, Applicant notes that the Examiner has very clearly failed to address the Applicants traversals regarding the failure of the applied references to disclose the features of the claimed invention and the complete and utter lack of any motivation to combine the references as alleged by the Examiner.

Rather, the Examiner merely regurgitates the very same allegations regarding a motivation to combine the reference despite the multiple deficiencies which prevent the Examiner from relying upon such an alleged motivation.

Therefore, again, Applicant submits that the Examiner has again failed to comply with the clear requirements that are set forth in the Manual of Patent Examining Procedure. In particular, the Examiner has failed to comply with the requirements of the M.P.E.P. as set forth in § 707.07(f) by failing to answer all material traversed.

Indeed, the Examiner does not mention anything at all about Applicant's traversals.

Applicant again submits, however, that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

Applicant submits that these references would not have been combined as alleged by the Examiner. Indeed, the references are directed to completely different and unrelated matters and problems.

One of ordinary skill in the art who was concerned with providing an improved call

interrupt feature for a telephone answering device that permits the telephone answering device to reestablish control over the message handling function without depending upon an elapse of time or an off-hook condition, as the Henderson reference is concerned, would not have referred to the Muramatsu reference. That is, the Muramatsu reference is directed to the completely different and unrelated problem of identifying a caller using sound alone without reducing the number of available communication lines. Thus, these references would not have been combined.

Even assuming arguendo that one of ordinary skill in the art would have been motivated to combine these references, the combination would not teach or suggest each and every element of the claimed invention.

As explained previously with respect to independent claim 13, from which claims 19-20 depend, the Henderson reference does not teach or suggest the features of independent claim 13, including a memory storing a character string input by a user for the calling party. As explained above, these features in combination with the other features of independent claim 13 are important for obtaining voice information by providing the instruction to the phone when an originator's information cannot be easily identified based upon the display and outputting the voice information in response to receipt of an instruction from a user during an incoming call.

The Muramatsu reference does not remedy the deficiencies of the Henderson reference.

The Muramatsu reference discloses storing a sound pattern in a phone directory and then outputting that sound pattern when a calling party corresponds to the sound pattern ([0036]). The sound pattern that is disclosed by the Muramatsu reference is the same as the

identification tone that is discussed, for example, at page 2, lines 5-10 of the present specification.

In other words, the Muramatsu reference does not teach or suggest anything at all that is related to outputting a character signal, let alone outputting voice information that corresponds to a character string that was input by a user.

Therefore, the Examiner is respectfully requested to withdraw the rejection of claims 19-20.

D. The Brennan reference in view of the Henderson reference

Regarding the rejection of claims 24-26, the Examiner alleges that the Henderson reference would have been combined with the Brennan reference to form the claimed invention. Applicant submits, however, that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

Applicant again submits that these references would not have been combined as alleged by the Examiner. Indeed, the references are directed to completely different and unrelated matters and problems.

Specifically, the Brennan reference is directed to providing a telephone system that automatically answers a telephone so that "someone in a hands-busy situation or a handicapped individual may have calls from pre-selected callers automatically connected." (Abstract).

In stark contrast, the the Henderson reference is directed to the completely different and unrelated problem of providing an improved call interrupt feature for a telephone

answering device that permits the telephone answering device to reestablish control over the message handling function without depending upon an elapse of time or an off-hook condition (col. 2, lines 15-21).

One of ordinary skill in the art who was concerned with providing a telephone system that automatically answers a telephone so that someone in a hands-busy situation or a handicapped individual may have calls from pre-selected callers automatically connected, as the Brennan reference is concerned with providing would not have referred to the Henderson reference. That is, the Henderson reference is concerned with the completely different and unrelated problem of providing an improved call interrupt feature for a telephone answering device that permits the telephone answering device to reestablish control over the message handling function without depending upon an elapsed time or an off-hook condition.

Thus, the references would not have been combined.

Further, Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner.

The Examiner alleges that it would have been obvious to modify the automatic answering system that is disclosed by the Brennan reference to "so that the user would recognize whom is calling before the phone goes off-hook."

However, contrary to the Examiner's allegation, and as explained above, one of ordinary skill in the art would not have been motivated to modify the Brennan reference to " that the user would recognize whom is calling before the phone goes off-hook" because the answering system that is disclosed by the Brennan reference already allows the user to recognize whom is calling before the phone goes off-hook.

Since the Brennan reference already allows the user to recognize whom is calling

before the phone goes off-hook, clearly, there is no motivation to modify the Brennan reference so " that the user would recognize whom is calling before the phone goes off-hook" as alleged by the Examiner.

Additionally, the Examiner admits that the Brennan reference does not teach or suggest outputting a voice signal in response to an instruction received from a user.

The Examiner then attempts to remedy the deficiencies of the Brennan reference by referring to the Henderson reference which appears to disclose outputting caller identification data as voice data in response to a user input.

However, contrary to the Examiner's allegation, one of ordinary skill in the art would not have modified the system that is disclosed by the Brennan reference because such a modification would destroy the intended purpose of the system that is disclosed by the Brennan reference.

Indeed, as explained previously, the Brennan reference very clearly teaches away from making any such modification.

In stark contrast, the Brennan reference discloses an automatic answer feature for a telephone that automatically outputs a name from a speech synthesizer without requiring any instruction at all from a user during the incoming call.

In particular, the Brennan reference explains that "Upon completion of a predetermined number of ring cycles (usually only one) . . . the main controller 34 compares the decoded telephone number (or, if no telephone number, the decoded name) to the telephone numbers (or names) previously entered into the telephone directory 48 (step 64). If there is a match . . . . the name in the matching record is read from the telephone directory 84 . . . [and] the main controller 34 forwards the read name to the speech synthesizer 80 (step 65)

which translates the read name into a voice announcement signal which is output to the handsfree speaker." (Col. 3, lines 3 - 31).

Thus, the automatic telephone answering system that is disclosed by the Brennan reference suffers from the same problem that is solved by the present invention.

In other words, the automatic telephone answering system that is disclosed by the Brennan reference automatically outputs the name as a voice announcement to the hands free speaker. Therefore, the voice announcement is heard in the surroundings of the phone without the user of the telephone doing anything.

In stark contrast, the present invention avoids having the voice information automatically being heard in the surroundings by outputting a voice signal in response to an instruction from the user during the incoming call.

Therefore, the Brennan reference actively teaches away from the present invention.

M.P.E.P. § 2145 X. D. 2. states:

"It is improper to combine references where the references teach away from their combination." (Emphasis added).

As explained above, the present invention avoids having the voice information automatically being heard in the surroundings by outputting the voice information in response to an instruction from the user during the incoming call.

In stark contrast, the Brennan reference teaches away from outputting voice information in response to an instruction from the user during the incoming call by providing an automatic telephone answering system which automatically outputs the voice information to the surroundings because the "operation is useful where the user is handicapped, infirm, or working in a hands-busy situation." (Col. 3, lines 48-57).

In other words, the Brennan reference teaches that the user may be "handicapped, infirm, or working in a hands-busy situation" and, therefore, may be unable to provide an instruction when receiving the incoming call in order to output the voice information into the surroundings. Therefore, the Brennan reference teaches that it is not desirable to require any instruction at all from a user before outputting the voice information into the surroundings.

Clearly, one of ordinary skill in the art would not have been motivated to modify the teachings of the Brennan reference to require that a user input be received before outputting voice information when the Brennan reference specifically teaches that it is not desirable to require any instruction at all from a user before outputting the voice information.

One of ordinary skill in the art at the time the invention was made would not have been motivated to combine these references to form the claimed invention.

Therefore, the Examiner is respectfully requested to withdraw the rejection of claims 24-26.

E. The Brennan reference in view of the Henderson reference and in further view of the Muramatsu reference

Regarding the rejection of claims 27-28, and 30, the Examiner alleges that the Henderson reference would have been combined with the Brennan reference and further alleges that the Muramatsu reference would have been combined with the Henderson reference and the Brennan reference to form the claimed invention. Applicant submits, however, that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

As explained above, Applicant submits that these references would not have been

combined as alleged by the Examiner. Indeed, the references are directed to completely different and unrelated matters and problems.

Further, one of ordinary skill in the art who was concerned with providing a telephone system that automatically answers a telephone so that someone in a hands-busy situation or a handicapped individual may have calls from pre-selected callers automatically connected, as the Brennan reference is concerned with providing, or who was concerned with identifying a caller using sound alone without reducing the number of available communication lines as the Muramatsu reference is concerned would not have referred to the Henderson reference. That is, the Henderson reference is concerned with the completely different and unrelated problem of providing an improved call interrupt feature for a telephone answering device that permits the telephone answering device to reestablish control over the message handling function without depending upon an elapsed time or an off-hook condition.

Thus, the references would not have been combined.

Further, Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner.

The Examiner continues to allege that it would have been obvious to modify the automatic answering system that is disclosed by the Brennan reference "so that the user would recognize whom is calling before the phone goes off hook."

However, as very clearly explained above, contrary to the Examiner's allegation, one of ordinary skill in the art would not have been motivated to modify the Brennan reference to "allow the user to recognize whom is calling before the phone goes off-hook" because the answering system that is disclosed by the Brennan reference already allows "the user to recognize whom is calling before the phone goes off-hook."

Additionally, the Examiner admits that the Brennan reference does not teach or suggest outputting the voice information in response to an instruction received from a user.

The Examiner then attempts to remedy the deficiencies of the Brennan reference by referring to the Henderson reference which appears to disclose outputting caller identification data as voice data in response to a user input as recited by independent claim 24 from which claims 27-28 and 20 depend.

However, as explained before, contrary to the Examiner's allegation, one of ordinary skill in the art would not have modified the system that is disclosed by the Brennan reference because such a modification would destroy the intended purpose of the system that is disclosed by the Brennan reference.

Indeed, as explained previously, the Brennan reference very clearly teaches away from making any such modification.

Clearly, one of ordinary skill in the art would not have been motivated to modify the teachings of the Brennan reference to require that a user input be received before outputting voice information when the Brennan reference specifically teaches that it is not desirable to require any instruction at all from a user before outputting the voice information.

One of ordinary skill in the art at the time the invention was made would not have been motivated to combine these references to form the claimed invention.

Therefore, the Examiner is respectfully requested to withdraw the rejection of claims 27-28 and 30.

IV. FORMAL MATTERS AND CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully submits that claims 1-28 and 30-32, all the claims presently pending in the Application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the Application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: 11/18/05

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